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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,602	11/09/2006	Ulrich Carlin Nielsen	SCAN1-41253	1498

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PEARNE & GORDON LLP
1801 EAST 9TH STREET
SUITE 1200
CLEVELAND, OH 44114-3108

EXAMINER	
LEE, LAURA MICHELLE	
ART UNIT	**PAPER NUMBER**
3724	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/599,602	NIELSEN, ULRICH CARLIN	
	Examiner	Art Unit	
	LAURA M. LEE	3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12/21/2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *22-32 and 34-42* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *22-32,34-42* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _____ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *10/03/2006; 1/15/2008*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. The restriction requirement has been rescinded due to applicant's amendments.

Information Disclosure Statement

2. The information disclosure statement filed 10/03/2006 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Specification

3. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

(a) TITLE OF THE INVENTION.
(b) CROSS-REFERENCE TO RELATED APPLICATIONS.
(c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
(d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
(e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
(f) BACKGROUND OF THE INVENTION.

(1) Field of the Invention.
(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.

(g) BRIEF SUMMARY OF THE INVENTION.
(h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
(i) DETAILED DESCRIPTION OF THE INVENTION.
(j) CLAIM OR CLAIMS (commencing on a separate sheet).
(k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
(l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 36, 38, and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 36 recites the limitation "said strips" in line 6. There is insufficient antecedent basis for this limitation in the claim.

Claim 36 recites the limitation "the strips" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 40 recites the limitation "wherein a feeding direction of said one or more additional cutting devices is different from that of said first cutting device." in lines 3-5. The limitations feeding device should be feeding stage in both instances and there is

insufficient antecedent basis for "said one or more additional cutting devices" regardless of the term device or stage.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 22-26, 28, 34-39, 41, 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Kim et al. (U.S. Publication 2003/0145699), herein referred to as Kim. Kim discloses a method for portion cutting a food item (fig. 1), comprising the steps of: cutting the food item into parts at a first cutting stage (step 108); cutting the parts into pieces of predetermined weight and dimension at a second cutting stage (step 120); scanning at least one of a shape, a structure, and a dimension of the food item at the first cutting stage by a measuring means (step 102); and determining a portion-cutting profile in connection with said scanning and on the basis of predetermined dimension and/or weight of the pieces by a processor means (step 103; CPU 212).

In regards to claim 23, Kim discloses wherein said determining said portion-cutting profile comprises the step of planning the whole of a cutting sequence (generate 3-d image; step 103).

In regards to claim 24, Kim discloses wherein at least a part of said portion cutting profile is carried out in said first cutting stage (step 108).

In regards to claim 25, Kim discloses feeding the item into a first cutting device (step 108), in which device the item is cut into strips in a cutting unit (i.e. paragraph [0019]); transferring the strips from the first cutting device to one or more additional cutting devices; and cutting in the one or more additional cutting devices, in which the strips are cut into pieces of predetermined shape (step 120).

In regards to claim 26, Kim discloses wherein scanning of the shape, structure, and/or dimension of the strips is performed in the one or more additional cutting devices (step 114).

In regards to claim 28, Kim discloses wherein at least a part of said portion cutting profile is communicated further to one or more of the additional cutting device (step 124)

In regards to claim 32, Kim disclose the step of non-manually placing the food item in the first cutting device and/or non-manually transferring the strips to one or more of the additional cutting devices (conveyor 202).

In regards to claim 41, Kim discloses wherein an apparatus for portion cutting a food item, comprises: a first cutting stage for cutting the food item into parts (step 108); a second cutting stage for cutting the parts into pieces of predetermined weight and dimension (step 120); measuring means for scanning at leas one of a shape, a structure, and a dimension of the food item at the first cutting stage(step 102), and a processor for determining a portion cutting profile in connection with said scanning and on the basis of predetermined dimension and/or weight of the pieces (step 103; CPU 212).

In regards to claim 34, Kim discloses wherein said processor (CPU 212) is arranged to plan the whole of a cutting sequence and thereby establish said portion cutting profile (inputs 106/ 118).

In regards to claim 35, Kim disclose wherein said first cutting stage (step 108) is adapted to carry out at least a part of said portion cutting profile.

In regards to claim 36, Kim discloses wherein measuring means (step 112) are arranged in said second cutting state for scanning at least one of shape, a structure and a dimension of said strips.

In regards to claim 37, Kim discloses wherein the processor (CPU 212) is arranged to send at least a part of the portion cutting profile to the second cutting stage (step 120). (See fig. 1)

In regards to claim 38, Kim discloses wherein transfer means(conveyor 202) for transferring one or more of the strips from the first cutting stage to the second cutting stage.

In regards to claim 39, Kim discloses placing means (conveyor 202) for placing the food item in the first cutting stage.

In regards to claim 42, Kim discloses wherein said second cutting stage is comprised of one or more cutting devices (paragraph 0055).

8. Claims 22, 27, 30, 41, are rejected under 35 U.S.C. 102(b) as being anticipated by Wadell (U.S. Publication 5,186,089). Wadell discloses a method for portion cutting a food item (10), comprising the steps of: cutting the food item into parts at a first cutting

stage (cutting knives 14); cutting the parts into pieces of predetermined weight and dimension at a second cutting stage (cutting unit 38; fig. 4); scanning at least one of a shape, a structure, and a dimension of the food item at the first cutting stage by a measuring means (ultrasonic sensors17); and determining a portion-cutting profile in connection with said scanning and on the basis of predetermined dimension and/or weight of the pieces by a processor means (computer; col. 3, lines 10-18).

In regards to claim 27, Wadell discloses wherein a feeding direction of said one or more additional cutting devices is difference from that of said first cutting device (fig. 4).

In regards to claim 30, Wadell discloses wherein a feeding direction for the one of more additional cutting devices lies substantially at right angles to a feeding direction for the first cutting device (fig. 4).

In regards to claim 41, Wadell discloses wherein an apparatus for portion cutting a food item, comprises: a first cutting stage for cutting the food item into parts (14); a second cutting stage for cutting the parts into pieces of predetermined weight and dimension (38); measuring means for scanning at leas one of a shape, a structure, and a dimension of the food item at the first cutting stage(17), and a processor for determining a portion cutting profile in connection with said scanning and on the basis of predetermined dimension and/or weight of the pieces (computer).

In regards to claim 40, Wadell discloses wherein a feeding direction of said one or more additional cutting devices is different from that of said first cutting device (fig. 4).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claim 29 is rejected under 35 U.S.C. 102(b) as being anticipated by Wadell (U.S. Publication 5,186,089). As best understood, Wadell does not disclose wherein the feeding directions for two or more additional cutting devices lie substantially parallel with one another as Wadell does not disclose a multiple cutters on the second cutting stage. However, the difference between the Wadell and the instant invention is the addition of another pusher 36 and out feed belt 39, such that more fish fillets 30 can be processed at a given time. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have added a second cutter in parallel with cutter 38, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

11. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al. (U.S. Publication 2003/0145699), herein referred to as Kim in view of Johnson et al. (U.S. Patent 5,566,600), herein referred to as Johnson. Kim does not disclose the step of manually placing the food item in the first cutting device and/or manually transferring the strips to one or more of the additional cutting devices. However, as in claim 32,

applicant is claiming that the step of placing the food item in the first cutting device or transferring the strips to one or more of the additional cutting devices is an automated process, it is apparent that this is not a critical aspect of the device. There can only be two options; manual or automated placement. Attention is also directed to the Johnson reference which discloses a slicing machine for meat loaves. Johnson discloses providing either an automated load loading door or a manual loaf loading apparatus on both or either side of the slicing machine for loading the loaves. Thus it is well known in the art to either manually or use an automated device to load the food item onto a conveyor for slicing the food product as is alternatively being claimed by applicant. One having ordinary skill in the art would have found it obvious to have either manually loaded the food items on the conveyor or to have utilized an automated system, as the end result would have been the same as providing a supply a food items to the beginning of the cutting system.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Publication 2006/0288832; U.S. Publication 2006/0156878; U.S. Patent 7,651,388; U.S. Patent 7,251,537; U.S. Patent 6,983,678; U.S. Patent 6,164,174; U.S. Patent 7,055,419;

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LAURA M. LEE whose telephone number is (571)272-

8339. The examiner can normally be reached on Monday through Friday, 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Laura M Lee/
Examiner, Art Unit 3724
3/14/2010